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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,230	02/20/2001	Mamiko Kuramochi	1046.1242 (JDH)	4371

21171 7590 08/28/2006

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EXAMINER

WONG, LESLIE

ART UNIT PAPER NUMBER

2164

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/785,230

Applicant(s)

KURAMOCHI, MAMIKO

Examiner

Leslie Wong

Art Unit

2164

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: The combination of Bence, Jr. et al. and Estrada et al. teaches the limitations as claimed.

The Applicant argues that Estrada fails to teach the claimed limitations: Independent claim 1, recites "... performs two different operations, a first operation ... firstly selects the data file... secondly drags the selected format file to the data file".

Examiner submits that Estrada teaches Applicant's claimed two steps operations indicated above as the drag and drop command that instructs the system to convert a data file to a fix format file/HTML file (col. 20, lines 46-67 and Fig. 16, element 244). As explained on page 8 of the Final Office Action dated April 1, 2006, the drag-and-drop operation includes Applicant's claimed selecting the file and drag operation as defined by Wikipedia as one has to first select the file before the system would allow the file to be drag and drop to move the file to another location.

Applicant further argues that it appears that the Office Action, as summarized by the Response to Argument section of the Office Action, is directed to the claims as presented before the Amendment Filed December 27, 2005, not as presently presented for examination. Thus, the features of the claims as presently presented have not been addressed.

In response to the preceding arguments, Examiner respectfully submits that Applicant's amendment filed December 27, 2006 to add the limitation "a specifying control unit implementing a specifying module which performs two different operations, a first operation in which the specifying module firstly selects the data file and second drags the selected data file to the format file, and secondly drags the selected format file to the data file" has been fully addressed by applying the reference Estrada et al. and provided the definition from Wikipedia as evidentiary document to further explain how the term of the art "drag-and-drop" reads on to the claimed limitations: "firstly select file ... secondly drag file...". As such, a prima facie cases of obviousness has been meet.

Finally, Applicant argues that Estrada et al. teaches away from dragging and dropping the form on the data file as Estrada et al. is silent as to delivery of the form to the non-HTML file because Estrada's ONE WAY delivery of a selected file is not reversible so that the form can be delivered to the non-HTML file.

In response to the preceding arguments, Examiner respectfully submits that in order to disqualify a reference based on a "teach away" reasoning, the reference has to explicitly suggest or disclose the so-called teach away steps – Applicants assertion can not be accepted if it is unsupported by a valid evidence. Even if Estrada is silent about a certain feature of the prior art, it does not necessarily mean that Estrada does not teach that particular feature.



Leslie Wong
Primary Patent Examiner